

REMARKS

Claims 16-28, 33-41, 42-53, and 58-65 are pending in the present application. Claims 16 and 42 were amended in this response to clarify the claim elements, and were not amended in any way pursuant to patentability. No new matter has been introduced. Favorable reconsideration is respectfully requested.

Claims 16-28, 33-53, and 58-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pequet et al.* (European Publication No. 0 689 303 A1) in view of *Carr et al.* (US Patent No. 6,091,948). The Applicant respectfully traverses this rejection for the following reasons.

Specifically, the present independent claims recite a mobile radio system comprising at least one base station and a first mobile station (operating as a repeater) that executes transmission and reception operations with the at least one base station and executes transmission and reception operations with a second mobile station. In claims 16 and 42, “the first mobile station switches on and off, at least one of manually and automatically, the transmission of signals from the second mobile station via the first mobile station to the base station, and the transmission of signals from the base station via the first mobile station to the second mobile station.” In other words, the first mobile station is able to control the repeater function between the second mobile station and the base station to inhibit uncontrolled energy consumption. Furthermore, by switching off the transmission between the second mobile station and the base station there is no connection between the second mobile station and the base station.

In contrast, *Pequet* discloses a communication system wherein a first mobile station M1 operates as a repeater and is able to exchange signals with a base station BS as well as other mobile phones M2, M3, and M4. This repeater function between mobile stations M3 and M4 and the base station BS via the mobile station M9 is disclosed in column 6, line 52 to column 7, line 1. By using the mobile station M1 as a repeater, the coverage area of the base station can be expanded. As was acknowledged in the Office Action (see page 3), *Pequet* does not teach the first mobile station switching on and off, at least one of manually and automatically, the transmission of signals as recited in claims 16 and 42.

Regarding *Carr*, the reference only discloses a single mobile station which can be powered up or down, wherein a call forwarding telephone number can be specified by the user or can be automatically activated by the mobile station when the mobile station is powering down. Having defined such a call forwarding telephone number, a second user who wants to call the first user will be sent directly to a communication device that is assigned to the call forwarding telephone number to enable access for the first mobile station user. The Office Action stated that it would have allegedly been obvious to one of ordinary skill in the art to modify *Pequet* to allow the first mobile station to switch on and off to control call-forwarding operation of the radio unit.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) (see MPEP 2141.02). Similarly, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (MPEP 2143.01). In the present case, the mobile station of *Carr*, having the function of automatically activating the call forwarding telephone number, is not properly combinable with the mobile communication system of *Pequet*. Using mobile station of *Carr* as the mobile station (M1) in the communication system of *Pequet* negates the coverage area of the base station, in particular to reach the mobile stations M3 and M4 by the base station, because the mobile station of *Carr* is not able to work as a repeater under such a configuration.

Furthermore, in the aforementioned communication system using the teachings of *Carr* and *Pequet*, the first mobile station is not able to switch on and off the transmission of signals from the base station via the first mobile station to a second mobile station or the transmission of signals from the second mobile station via the first mobile station to the base station. While the first mobile station of *Carr* can be powered up and down, by simply combining the teaching of *Carr* with the teaching of *Pequet* there is no teaching provided to control the transmission between the base station and a second mobile station. To suggest such a combination would

render the prior art unsatisfactory for its intended purpose and would change the principle of operation as a result (MPEP 2145).

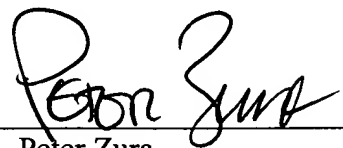
As an example, the first mobile station M1 of *Pequet* would be enabled to activate a call forwarding telephone number with a specified telephone number using the mobile station M2 as a call forwarding telephone number while powering down. If a third mobile station user wants to call the first mobile station, the third party is forwarded to the second mobile station M2. Although the connection between a base station and the second mobile station is activated by the first mobile station, the first mobile station cannot control the transmission between the base station and the second mobile station (i.e. cannot switch on and off the transmission). Consequently, the powering down and powering up according to *Carr* does not operate in the same manner as the switching on and off according to the present claims. Also, according to the present claims, when the switching on and off between the base station and the second mobile station occurs via the first mobile station, the first mobile station is not being powered up or down. To the contrary, only the repeater function of the first mobile station is activated or deactivated, as described in the specification on page 3 in lines 25 to 29.

In light of the foregoing comments, the Applicant respectfully submits that claims 16 and 42 are not taught or suggested by *Pequet* and *Carr* either combined or taken separately, and the rejection of this claim should be withdrawn, accordingly.

With respect to dependent claims 17-28 and 33-41, which ultimately depend from claim 16, these claims are believed to be allowable under merits and at least for the reasons presented above with respect to independent claim 16. Additionally, claims 43-53, and 58-65, which ultimately depend on claim 42, are also believed to be allowable under merits and at least due to their dependency on independent claim 42. The Applicant respectfully submits that the application is in condition for allowance and requests that a timely Notice of Allowance be used in this case.

Respectfully submitted,

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